

**REMARKS**

Claims 1, 6, 8, 11, 16, 18, 19, 26, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 6, 8, 11, 16, 18, 19, 26, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. Claims 1-3 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,477,543 issued to Huang et al. (Huang) in view of U.S. Patent No. 7,120,675 issued to Shupak et al. (Shupak). Claims 3-6, 8, 9, 11-16, 18, 19, 21-26, 28, 29, 31, and 33-40 are rejected under 35 U.S.C. §103 as being unpatentable over Huang in view of Shupak and further in view of U.S. Patent Application Publication No. 2001/0005849 filed by Boothby et al. (Boothby). In light of the foregoing amendments and following remarks, Applicants respectfully request the Examiner's reconsideration and reexamination of all pending claims.

Applicants have amended the claims to correct the errors noted in the 35 U.S.C. §112 rejections. Applicants assert that all claims are in compliance with 35 U.S.C. §112.

The Office Action rejected independent Claim 1 as being unpatentable over Huang in view of Shupak. The remaining independent claims were rejected as being unpatentable over Huang in view of Shupak and Boothby. Applicants traverse the rejection for the following reasons. The Office Action admits that Huang does not teach:

comparing the first information with information stored on the handheld device that is indicative of a version of the application on the handheld device;

updated the application on the handheld device using metadata received from the server if the first information does not compare equally with the information that is indicative of the version of the application on the handheld device, wherein the metadata comprises application definitions.

But the Office Action asserts Shupak teaches these missing limitations citing the Abstract, column 10, lines 12-36, column 10, lines 50-column 11, line 24, and Claim 1 of Shupak in support thereof. Applicants have reviewed these cited sections of Shupak and can find no teaching or fair suggestion of the aforementioned limitations of independent Claim 1 either alone

or in combination with the remaining limitations of independent Claim 1. Shupak relates to an information location service. More particularly, Shupak relates to a mechanism for locating solution access information and then obtaining and implementing the correct solution for updating software programs. In Shupak, a user tells one system what information the user is interested in, and the one system replies with the location of where the desired information can be found. A user will have to make basically no changes to the system, and instead will automatically discover the name location of a server that will provide the user with the information sought to be obtained.

Figure 4 of Shupak illustrates a method for locating information associated with the local file. As shown in Figure 4, the method includes packaging metadata extracted from the local file into a request. The metadata can be packaged into query which specifies a request to locate an updated version of the local file. The request is sent to a set of locator servers that contain location information for information associated with the local file. A set of servers, in response, provides information back to the client in the form of redirect, or the set of servers can connect the client directly to a server having the information associated with the local file. If the client is not directly connected to the sought after information, the location information is used to query an appropriate server having the information. Presumably, Shupak teaches that the needed information is retrieved from the appropriate server and provided to the client.

While Shupak may describe sending a request to the cited locator servers, wherein the request may be one for locating an updated version of the local file or a request to locate a specific build version of an executable file, nothing in the cited sections of Shupak teach or fairly suggest Claim 1's requirement of "comparing the first information with information stored on the handheld device that is indicative of a version of the application on the handheld device" and "updating the application on the handheld device... if the first information does not compare equally with the information that is indicative of the version of the application on the handheld device." Indeed, a word search for the term "compare" and its derivatives (e.g., compares, compared, comparing) indicates that this term is not employed in Shupak.

MPEP 2142 defines the requirements that must be met to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires the prior art references must teach or suggest all the claim limitations. As noted above, the cited sections of Huang and Shupak fail to teach or fairly suggest the aforementioned limitations of independent Claim 1.

Accordingly, Applicants submit that the Office Action has failed to establish a *prima facie* basis for rejecting independent Claim 1. Independent Claims 11 and 21 also include limitations that are similar to the limitations of independent Claim 1 argued above. Applicants assert that the Final Office Action has failed to provide a *prima facie* basis for rejecting independent Claims 11 and 21 for the same or similar reasons set forth above.

Independent Claim 31 does not recite the limitation of “comparing the first information with information stored on the handheld device that is indicative of a version of the application on the handheld device.” However, independent Claim 31 does recite “a device configured to determine whether the handheld device has sufficient unused memory to store the data provided by the server.” The Office Action does not assert that the combination of Huang, Shupak, and Boothby teaches the aforementioned limitation of independent Claim 31. As such, Applicants assert the Patent Office has failed to provide a *prima facie* basis for rejecting independent Claim 31.

The remaining claims depend directly or indirectly from independent Claims 1, 11, 21, and 31. Since the Office Action has failed to provide a *prima facie* basis for rejecting these independent claims as argued above, Applicants assert the Office Action has failed to also provide a *prima facie* basis for rejecting the dependent claims.

**CONCLUSION**

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,



Eric A. Stephenson  
Attorney for Applicants  
Reg. No. 38,321  
Telephone: (512) 439-5093  
Facsimile: (512) 439-5099